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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,946	11/26/2003	Timothy A. Bekkedahl	C-2370B	9625

7590 06/07/2006

M.P. Williams
210 Main Street
Manchester, CT 06040

EXAMINER

WILLIAMS, SHERMANDA L

ART UNIT PAPER NUMBER

1745

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,946

Applicant(s)

BEKKEDAHL ET AL.

Examiner

Shermanda L. Williams

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

FUEL CELL HAVING A HYDROPHILIC SUBSTRATE LAYER

Examiner: Williams S.N. 10/722,946 Art Unit: 1745

Response to Amendment

This Office Action is responsive to the Amendment After Non-Final Rejection filed on March 29, 2006. Claims 1-3 are allowable for the reasons as stated in previous correspondence and claims 4 and 5 are rejected below.

1. Applicant's request (Amendment After Non-Final Rejection filed 3/29/06) for reconsideration of the rejection presented in the first Office action is persuasive and, therefore, the rejection of claims 4 and 5 as presented in the Office Action dated 02/06/06 is withdrawn.

Oath/Declaration

The requirement for a substitute declaration has been withdrawn.

Specification

The following is a quotation of the first paragraph of 35 U.S.C. 132

Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in

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his claim for a patent, with or without amendment, the application shall be reexamined.

No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: pressure difference between the coolant stream and the reactant stream of more than 0.2 and less than 1.7 psi is not clearly presented in the specification of the current application or the specification of the related application 10/012,157.

3. The continuation of application 10/012,157 filed on 11/26/2003 is objected to under 35 U.S. C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no continuation of application shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: pressure difference between the coolant stream and the reactant stream of more than 0.2 and less than 1.7 psi. The specification of the current application states a range of more than zero psi but less than two psi. There is no

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disclosure of the 0.2 psi to less than 1.7 psi range in the parent application 10/012,157.

The introduction of this range in claims 4 and 5 of the current application is new matter for which the specification provides no clear guidance. Applicant is invited to point to the support of this new matter within the filed disclosure. If no such support can be provided, cancellation of the new matter is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification of the current application states a range of more than zero psi but less than two psi. There is no disclosure of the 0.2 psi to less than 1.7 psi range in the parent application 10/012,157 or in the current application. There is insufficient evidence that the applicant had knowledge of the claimed invention at the time application 10/012,157 or the current application was filed.

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5. Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The pressure difference between the coolant stream and the reactant stream of more than 0.2 and less than 1.7 psi is not presented in the specification of the current application or the parent application 10/012,157. The differential pressure given in the specification is the range of more than zero psi but less than two psi. There is no evidence that the applicant provided for the enablement of claims 4 and 5 within the specification.

6. In MPEP 2164 and 2164.01 states "...when claimed subject matter is only presented in the claims and not in the specification portion of the application, the specification should be objected to for lacking the requisite support for the claimed subject matter... it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988)." The scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shermanda L. Williams whose telephone number is

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(272) 571-8915. The examiner can normally be reached on Mon.-Thurs. 7 AM - 4:30 PM and alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (272) 571-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER
